

Amendments to the Drawings

The attached replacement sheet of drawings provided in the Appendix to this Amendment includes changes to FIG. 1A. This sheet, which includes FIGS. 1A and 1D, replaces the original sheet including FIGS. 1A and 1D. In FIG. 1A, lines indicating the burial vault have been added.

Support for this addition can be found in at least paragraph [0003] of the Specification.

REMARKS

At the time of the Office Action, claims 1, 3, 4 and 6–25 were pending. Claims 7–15 and 19 are withdrawn. Claims 1, 3, 4, 6, 16–18 and 20–25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0167706 (Paza) in view of U.S. Patent No. 4,219,596 (Takemoto et al.). In addition, claims 16–18 and 20–25 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants thank the Examiner for his time, effort, and the courtesy extended in conducting the telephone interview with Applicants' representative, despite not having reached agreement about allowable subject matter.

Applicants have amended claims 16 and 17 in order to clarify the scope of the invention and request reconsideration of the application based on these amendments and the discussion presented below. Applicants have further cancelled the withdrawn claims.

Drawing Objections

1. Applicants have revised the drawings to include the burial vault.

In the Office Action, on pp. 2–3, the Examiner objected to the drawings as not showing the container/burial vault as claimed in claims 18–19.

Applicants have therefore revised Figure 1A in the attached drawing replacement sheet to show the burial vault associated with the carapace, in compliance with 37 C.F.R. §1.121(d). Support for this amendment can be found in at least paragraph [0003] of the Specification and no new matter has been added.

Since Applicants' amendments to the drawings have fully addressed the issue raised by the Examiner in the Office Action, Applicants respectfully request that the objection to the drawings be withdrawn.

35 U.S.C. §112, Second Paragraph, Indefiniteness of Claims 16–18 and 20–25

2. The carapace could be considered as part of a generic container, and therefore it is not inaccurate to indicate a substrate being attached to a generic container.

In the Office Action, on p. 3, the Examiner rejected claims 16–18 and 20–25 as being indefinite under 35 U.S.C. §112, second paragraph, asserting that the phrasing of claims 16–18

is inaccurate because the substrate is not attached to the container (burial vault), but rather to the carapace, noting that the “carapace” for a burial vault is known in the art as a structure which mates with the upper surface of the lid of a burial vault.

Applicants respectfully note that the “container” referred to in claim 16 could be generic to the urn of the non-elected as well as a container formed by the burial vault combined with carapace. The burial vault, with the carapace, would indeed form a “container,” as claimed.

Therefore, the present claim language is not indefinite, and is accurate, because the substrate is, in fact, attached to a first surface of such a container (formed of the burial vault and carapace). Given that one of ordinary skill in the art would understand the “carapace” as being a structure which mates with the upper surface of the lid of a burial vault, one of ordinary skill in the art would understand the carapace as being a part of a generic container as well.

For this reason, Applicants assert that these claims are not inaccurate and indefinite and respectfully request that the rejection under 35 U.S.C. §112 be withdrawn from the application.

35 U.S.C. §103(a) Obviousness of Claims 1, 3, 4, 6, 16-18 and 20-25 over Pazar in View of Takemoto

3. One of ordinary skill in the art would not seek to combine Pazar, teaching a durable identification nameplate, with Takemoto, teaching a transparent film decorative label to arrive at the invention claimed by claims 1, 16, as amended, and 17.

In view of the following remarks and the attached revised supplemental commercial success declaration, Applicants respectfully traverse the rejection of this claim under 35 U.S.C. 103(a). Applicants additionally respectfully traverse the same rejection of dependent claims 3, 4, and 6 as they depend from independent claim 1.

In the Office Action, on pp.3–4, the Examiner rejected independent claim 1 as being obvious over Pazar in view of Takemoto.

In the Office Action, the Examiner indicated that Pazar discloses a metal substrate having a decorative graphic attached/adhered to a top surface. The Office Action further notes that while Pazar discloses a metal substrate having a decorative graphic it “fails to

disclose the substrate as being a transparent substrate having a decorative graphic printed thereon wherein the substrate is attached to the carapace via an adhesive (transparent).”

To cure this deficiency, the Examiner provided the Takemoto reference as disclosing, “a transparent substrate 16 having a decorative graphic 18 printed thereon wherein the substrate is attached to a structure via a transparent adhesive...such that the graphic appears to be part of the structure as opposed to appearing ‘stuck on’....”

The Examiner stated, as a motivation to combine these references:

...it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pazar by replacing the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive to enhance the appearance of the vault.

This rejection was essentially repeated from the previous office action.

Applicants responded to the prior office action by asserting that there was no teaching or suggestion in Pazar for combining the teachings of Pazar with those of Takemoto.

In the Response to Arguments section on pp. 6–7 of the Office Action, the Examiner disagreed with the Applicant-asserted lack of motivation to combine. The Examiner did acknowledge that there is no explicit discussion in Pazar of avoiding a “stuck on” appearance of the nameplate or of improving the appearance of the nameplate on a surface.

However, the Examiner also indicated that such an explicit discussion is not required for a proper combination of Pazar and Takemoto. The Examiner indicated:

Pazar and Takemoto both disclose a label (substrate) including indicia thereon. The transparent substrate of Takemoto is a more visual[ly] appealing arrangement than that of the metal substrate of Pazar as previously discussed in detail, and per knowledge generally available to one of the ordinary skill in the art, it would have been obvious to combine these references to create an aesthetically improved burial vault.

The problem addressed by the invention is how to increase the desirability of burial vaults, particularly given the fact that the burial vault is not typically used in a funeral service or public viewing other than the brief services that typically accompany the burial graveside.

Pazar recognized that providing durable identification and data about the deceased in connection with the burial vault would improve its desirability (see paragraph [0008]). Pazar achieves this by two mechanisms—as to the data about the deceased, a durable and sealed record receptacle 140 is provided that can contain a written record provided by friends and family of the deceased. This small record receptacle is designed to be placed in a receiving hole of the burial vault and sealed, where its contents are relatively immune from the elements. As to durable identification, Pazar achieves this by a name plate 2310 made of metal [0084] adhered to the lid.

Therefore, Pazar recognized one of many ways for improving the desirability of a burial vault, namely by enhancing a preservation of the identity and information associated with the deceased. In the event that, e.g., a flood carries away the burial vault, the problems associated with identifying its contents can be avoided [0002]. However, this solution is not an appearance-related solution.

There are numerous other potential mechanisms that could be used to enhance the desirability of a burial vault. A brief and informal survey of the industry indicates that other non-appearance-related solutions have been implemented, such as strength, integrity, protection from the environment, materials, etc. And for those few mechanisms that could conceivably be appearance-related, these seem to revolve around cross-sectional shapes, molding, and characteristics of the materials used.

In the present application, the Applicants recognized a solution to improving the desirability of a burial vault that had not been recognized before—the addition of a graphic label to enhance the overall desirability of the burial vault by visual means that does not involve cross-sectional shapes, moldings, etc. This solution had not been recognized in the industry previously.

In Pazar, the issue being addressed is the durability of identifying indicia. Therefore, it would make sense in Pazar to construct the identifying indicia name plate of a very durable material—namely metal. The attributes of the substrate in claim 1 are not those that one of ordinary skill in the art would turn to if the issue of durability was of primary concern, as the metal nameplate of Pazar would much better serve as a durable identifying indicia. Therefore, one of ordinary skill in the art would not consider the teaching of Pazar in improving the

desirability of a burial vault as is achieved in present claim 1 by providing durable identifying and describing indicia in the form of a metal nameplate and environmentally sealed data capsule, and would not have a motivation to consider the use of the labels disclosed by Takemoto if such durability were a concern.

Applicants have amended independent claims 16 and 17. Claim 16 has been amended to include a requirement for a particular condition associated with the substrate upon which the graphic image is supplied. Claim 17 has been amended as an independent claim so as not to include the further limitations added by the present amendment to claim 16.

Applicants have amended claim 16 to incorporate additional attributes of the substrate. The attributes of the substrate added to claim 16 are not those that one of ordinary skill in the art would turn to if the issue of durability was of primary concern, as the metal nameplate of Pazar would much better serve as a durable identifying indicia. Therefore, one of ordinary skill in the art would not consider the teaching of Pazar in improving the desirability of a burial vault by providing durable identifying and describing indicia particularly illuminating with regard to the present invention, as discussed above.

Similarly, with regard to claim 17, as currently amended, the substrate covers substantially the first surface of the container. One concerned with providing a desirable burial vault as presently claimed by claim 17 would not turn to the durable identifying indicia disclosed by Pazar since it would make no sense to provide a nameplate that covers substantially the first surface of the container. Secondly, even if such a large nameplate were desirable, then its construction out of a durable metal would make it cost prohibitive, at least in a commercially viable marketplace.

In the present Office Action, the Examiner has engaged in impermissible hindsight in combining the references of Pazar and Takemoto. The Examiner has used the Applicants own disclosure as providing the motivation and desirability for providing combining the references to arrive at the presently claimed solution. Out of the myriad of possible ways of improving the desirability of a burial vault, numerous other mechanisms have been employed (durability of identifying indicia, structural aspects, moldings, etc.), but no one recognized that providing a graphical label, as presently claimed, would achieve the improvement of desirability presently achieved.

As prohibited by MPEP §2145(X)(A), the Examiner, having taken the cue from the Applicant's disclosure that the addition of a graphic label having the claimed attributes is a solution for making a burial vault more desirable, then, simply in hindsight, located the Takemoto reference showing such a label, and concluded that this would have been an obvious combination. It was unknown, at the time the invention was made, that the addition of a graphic image having the claimed features would result in a more desirable burial vault, and one at the time of the invention could have determined that such a feature was actually undesirable or, at the very least, unnecessary.

As noted by MPEP §2143.01(III), the mere fact that the references can be combined or modified may not be sufficient to establish *prima facie* obviousness. Here, the Examiner has simply pointed to two references that teach differing aspects, differing applications, and different motivations for use and concluded that one of ordinary skill in the art would be motivated to combine them. Again, however, this is only after the solution of applying a graphic in accordance with the disclosure of the invention was taught by the applicants. The motivation cited by the Examiner "to enhance the appearance of the vault" (p. 4) and "the transparent substrate of Takemoto is a more visual[ly] appealing arrangement than that of the metal substrate of Pazar" fails to take into account the many possible ways for enhancing the appearance of the vault, the other ways historically used to enhance the desirability and appearance of the burial vault, and the fact that Pazar's motivation includes durability for identification purposes.

Thus, for these reasons alone, Applicants respectfully assert that the independent claims of the present invention, with claims as amended, is not obvious over the combination of Pazar and Takemoto.

4. The revised declaration of Marty Jay Cox demonstrates the non-obviousness of the present invention by demonstrating commercial success of the invention.

In addition to the above arguments, however, the Applicants have submitted a revised declaration of Marty Jay Cox with demonstrates the non-obviousness of the present invention by its commercial success.

In the previous response to an earlier office action, Applicants submitted an Affidavit / Declaration pursuant to 37 C.F.R. §1.132, which argued that the commercial success of the product being sold further supported its non-obvious nature.

In the Office Action, on pp. 7–8, the Examiner concluded that this declaration was insufficient to overcome the rejection under 35 U.S.C. §103 based on a number of deficiencies.

As the Examiner noted, the previously submitted declaration did not make reference to individual claims of the application, and only relied upon gross sales figures to demonstrate commercial success, absent evidence as to market share.

Applicants have therefore submitted herewith a revised declaration of Marty Jay Cox that addresses these deficiencies. An executed copy of the declaration is provided in Appendix B, with supporting Exhibits. This executed copy, for reasons that are unclear, lost the paragraph numbering during the process of electronic transmission between the Applicants' representative and Mr. Cox. However, an unsigned copy of the declaration, which is identical to the executed version with the exception that it includes the properly numbered paragraphs, is provided in Appendix C for ease of reference.

With respect to paragraph no. 7 of the declaration, the Examiner's attention is directed to a revision from the previously submitted declaration that includes a recitation of the features of at least claim 1 in the application, thereby addressing the Examiner's first cited basis of insufficiency.

Paragraph nos. 8–15 provide the best evidence available to the Applicants as to the gross market sales figures. Although some of the values used are based on market projections (projections vs. actuals are clearly identified in the declaration), these projections are provided by a well-respected, unbiased, and well-established industry organization. This evidence shows that despite an overall trend resulting in more cremations and a decreasing demand for burial vaults, the Applicants percent of market share has steadily increased over the years.

Furthermore, as indicated in the declaration, no solution to increasing the desirability of burial vaults to consumers according to the presently claimed invention existed in the marketplace prior to the Applicants showing at a trade show—however, in the immediate

year following this showing, there was an explosion among competitors in the marketplace for products precisely in line with what was shown at the trade show and what was claimed in the present patent application.

Having addressed the Examiner's indication of shortcomings in the previous declaration with the presently submitted revised declaration, Applicants respectfully assert that this declaration and its supporting exhibits provide compelling evidence of non-obviousness in accordance with the criterion established in *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

CONCLUSION

Based on the claim amendments and the discussion presented above, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/brian c. rupp/

Brian C. Rupp, Reg. No. 35,665
Mark Bergner, Reg. No. 45,877
DRINKER BIDDLE & REATH LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606-1698
(312) 569-1000 (telephone)
(312) 569-3000 (facsimile)
Customer No.: 08968

Date: July 8, 2008

In re Appln. of Cox et al.
Application No. 10/775,746
Response to Office Action of February 8, 2008

APPENDIX A
DRAWING CHANGES